1   **REMARKS**

2   The Applicant respectfully requests reconsideration and allowance of claims 1-2, 4-7, 9-

3   12, 14-16, and 18-20 in view of the following arguments.

4   The Applicant appreciates the telephone interview conducted on September 9, 2004,

5   between the Examiner and Applicant's attorney, Russell D. Culbertson. In the telephone

6   interview, the Applicant's attorney noted that the first Office Action did not reference the

7   Information Disclosure Statement (IDS) filed January 18, 2002. The Applicant's attorney also

8   noted that the claims are amended in this response to distinguish over the reference cited in the

9   January 18, 2002 IDS, and that the claims are patentable over the reference cited in the first

10   Office Action for the reasons described in detail below. No agreement was reached as to

11   allowability, however, the Examiner indicated that he would consider the amended claims in

12   light of the January 18, 2002 IDS.

13

14   I.   THE AMENDMENTS TO THE CLAIMS

15   The present application was originally filed with claims 1 through 20. Claims 3, 8, 13,

16   and 17 are canceled above leaving claims 1-2, 4-7, 9-12, 14-16, and 18-20 pending in the case.

17   Independent claims 1, 11, and 16 are amended above to distinguish over the information

18   included in the IDS filed January 18, 2002. The dependent claims are amended accordingly. In

19   addition, claim 2, 14, and 15 are amended to correct a typographical error.

Page 10 of 15

1   II.   CLAIMS 1-20 ARE NOT ANTICIPATED BY THE KWATINETZ REFERENCE

2   Claims 1-20 were rejected under 35 U.S.C. 102(b) as being anticipated by Patent No.

3   5,574,840 to Kwatinetz et al. (the "Kwatinetz patent" or "Kwatinetz"). The Applicant

4   respectfully traverses these rejections.

5

6   Claim 1

7   Claim 1 requires "receiving an edit function input entered through the user input

8   arrangement, the edit function input defining an edit operation" and "identifying a target in

9   response to the edit function input, the target comprising an object appearing on the display as

10   specified by proximity to the pointer at the time the edit function is received..." Claim 1 also

11   requires "identifying a first target string for the target if the state of the target indicates that the

12   edit operation is currently applied to the target" and "applying the edit operation to the first target

13   string if the state of the first target string indicates that the edit operation is not currently applied

14   to the first target string." The Kwatinetz patent does not teach or suggest receiving an edit

15   function and identifying a target in response to the edit function input. Rather, Kwatinetz

16   discloses selecting text in one text selecting mode or another, and then invoking a desired edit

17   function input. In addition, Kwatinetz does not teach or suggest identifying a first target string

18   and applying the edit operation based on the state of the first target string, as required by claim 1.

19   The Kwatinetz patent only discloses a method and apparatus for determining when to switch

20   between two different text selection modes, each mode providing a different granularity of

21   selection. In particular, the Kwatinetz patent teaches a system in which a user positions a mouse

22   at an anchoring point and drags the mouse to select a certain amount of text. The amount of text

Page 11 of 15

1   selected depends on the current text selection mode. The text selection mode depends on user

2   input, the movement of the mouse, or the amount of time the mouse has remained stationary.

3   (col. 3, line 55-col. 4, line 22 of Kwatinetz)

4   Therefore, since the Kwatinetz patent does not teach or suggest all of the elements

5   required in claim 1, claim 1 is not anticipated by the Kwatinetz patent and is entitled to

6   allowance with its respective dependent claims, claims 2, 4-7, and 9-10.

7   Independent claims 11 and 16 include requirements similar to those of independent claim

8   1, mainly that an edit function input is entered through a user input arrangement, a target and first

9   target string are identified in response to the edit function input, and the edit operation is applied

10   to the target and the first target string under certain conditions of the respective targets.

11   Therefore, the arguments presented above with respect to claim 1, apply with equal force to

12   claims 11 and 16. Thus, claims 11 and 16 are not anticipated by Kwatinetz and are entitled to

13   allowance together with their respective dependent claims, claims 12, 14-16, and 18-20.

14

15   <u>Claims 5 and 7</u>

16   Although claims 5 and 7 are entitled to allowance based on the allowability of claim 1,

17   these claims are also entitled to allowance on grounds independent from those of the allowable

18   base claim.

19   Claim 5 requires "identifying a second target string for the target if the state of the first

20   target string indicates that the operation is currently applied to the first target string" and

21   "applying the edit operation to the second target string if the state of the second target string

22   indicates that the edit operation is not currently applied to the second target string." In addition,

Page 12 of 15

1   claim 7 includes similar identifying and applying requirements for a third target string. The

2   arguments presented above for claim 1 with respect to identifying and applying an edit operation

3   to a target and first target string also apply to claims 5 and 7 in that Kwatinetz does not teach or

4   suggest the identification of a second or third target string and applying an editing operation to

5   those strings. Therefore, claims 5 and 7 are allowable both as being dependent on an allowable

6   base claim and in view of the limitations they directly add.

7   In addition, claims 14, 15, 18, and 19 have the same requirements regarding the

8   identification of second and third target strings and applying an edit operation to each of those

9   strings if the state of the respective second or third target string indicates that the edit operation is

10   not currently applied to that respective string. Therefore, claims 14, 15, 18, and 19 are also

11   allowable both as being dependent upon an allowable base claim and in view of the limitations

12   they directly add.

13

14   III.   SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

15   The Applicant filed a second IDS in the present application on January 18, 2002 (this date

16   being the date stamped by the USPTO on the return postcard which accompanied this IDS).

17   However, the currently outstanding Office Action did not acknowledge the January 18, 2002 IDS

18   and did not acknowledge consideration of the reference cited therein. The Applicant respectfully

19   requests that Examiner acknowledge consideration of the January 18, 2002 IDS together with the

20   reference cited in this IDS.

21   The reference included in the January 18, 2002 IDS arguably anticipates the functionality

22   claimed in original claims 1, 11, and 16 regarding identifying a target and applying an edit

Page 13 of 15

1   operation to the target. In particular, the reference teaches "To change a single word, just click it

2   to place the insertion point in the word, and apply any changes, such as bold or italic." However,

3   the reference does not teach or suggest the functionality of original claims 3, 13, and 17.

4   Specifically, the reference does not teach or suggest "identifying a first target string if the state of

5   the target indicates that the edit operation is currently applied to the target" and "applying the edit

6   operation to the first target string if the state of the first target string indicates that the edit

7   operation is not currently applied to the first target string." Therefore, claim 1 is amended above

8   to include the limitations previously set out in claim 3, claim 11 is amended to include the

9   limitations previously set out on claim 13, and claim 16 is amended to include the limitations

10   previously set in claim 17.

1   IV.   CONCLUSION

2   For all of the above reasons, the Applicant respectfully requests reconsideration and

3   allowance of claims 1-2, 4-7, 9-12, 14-16, and 18-20. If the Examiner should feel that any issue

4   remains as to the allowability of these claims, or that a further conference might expedite

5   allowance of the claims, he is asked to telephone the Applicant's attorney, Russell D. Culbertson,

6   at the number listed below.

7

8   Respectfully submitted,

9
10   The Culbertson Group, P.C.
11
12
13   Dated: September 10, 2004   By:_____
14   Russell D. Culbertson, Reg. No. 32,124
15   Russell Scott, Reg. No. 43,103
16   Trevor Lind, Reg. No. 54,785
17   1114 Lost Creek Blvd., Suite 420
18   Austin, Texas 78746
19   512-327-8932
20   ATTORNEYS FOR APPLICANT
21
22
23   CERTIFICATE OF FACSIMILE
24
25
26   I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, (Fax
27   No. 703-872-9306) on September 10, 2004.
28
29
30   Reg. No. 32,124, Russell D. Culbertson_____
31
32

1064.resp.6-18-04 OA.wpd   Page 15 of 15